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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,433	09/30/2003	Edward E. Kelley	FIS920030177US1	2432
29371 7590 01/18/2008 CANTOR COLBURN LLP - IBM FISHKILL 20 Church Street 22nd Floor Hartford, CT 06103			EXAMINER PHAM, KHANH B	
			ART UNIT 2166	PAPER NUMBER
			MAIL DATE 01/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/605,433

Applicant(s)

KELLEY ET AL.

Examiner

Khanh B. Pham

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,5-23 and 39-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,5-23 and 39-43 is/are rejected.
- 7) ☒ Claim(s) 11-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Objections

1. **Claims 11-17** are objected to because of the following informalities:

- Claim 11 depends on itself.
- Claim 17 depends on canceled claim 1.

For purposes of examination, claims 11 and 17 will be treated as dependent of claim 18. Appropriate correction is required.

Allowable Subject Matter

2. **Claims 23, 39-43** are allowed.

The following is a statement of reasons for the indication of allowable subject matter: prior art of record do not teach the combination of the claimed elements including the steps of "determining if a virtual private network is required; checking for remote access to said virtual private network when it is required; if said remote access does not exist, identifying a third party provider to provide secure, encrypted connection between a private network and remote users" and "accessing said process software through said site-to-site configuration with large scale encryption" as recited in independent claims 23, 39. Thus, prior art of record neither renders obvious nor anticipates the combination of claimed elements in light of the specification. After a further search and a thorough examination of the present application and in light of the prior art made of record, claims 23, 39-43 are allowed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 2, 5-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. (US 2003/0033288) and in view of Conner et al. (US 6,816,882 B1), hereinafter **Shanahan** and **Conner**.

As per claim 18, Shanahan teaches a method for providing web-based electronic research and presentation function via a document creation application comprising:

- “scanning an active document on a computer device operable for identifying relevant keywords” at [0008], [0009], [0131];
- “searching at least one database for reference materials relating to said relevant keywords” at [0132], [0135];
- “automatically displaying relevant materials on said computer device” at [0120], [0189], [0285], [0339] and Fig. 63;
- “converting said reference material if said reference material are in a format different from a format used in creating said active document” at [0139], [0503], [0525];

- “displaying said reference materials on said computer device” at [0219];
- “wherein said active document includes data currently being entered or edited by a user on said computer device” at [0138];
- “wherein said scanning an active document on a computer device operable for identifying relevant keywords is performed by an intelligent search agent, said method further including: scanning text of an active page for said active document for at least one of: frequently appearing terms” at [0007], [0255], [0307], and Figs. 21, 22, 28;
- “frequently appearing phrases” at [0307] and Fig. 28;
- “and specific terms requested by said user at [0294], [0295], [0298];
- “determining relevance of found terms or phrases resulting from said scanning, said determining relevance of found terms or phrases based upon rules prescribed by said intelligent agent” at [0158], [0319], [0320];
- “and storing relevant results in a temporary storage location operable for performing said searching” at [0180].

Shanahan does not teach the steps of integrating process software as claimed. However, Conner teaches the steps of integrating process software for providing said web-based electronic research and presentation functions via a document creation application, said integrating comprising:

- “determining if said process software will execute on at least one server; identifying an address of said at least one server; checking said at least one server for operating systems, applications, and version numbers for validation

with said process software, and identifying any missing software applications for said at least one server that are required for integration" at Col. 13-14 and Figs. 8-9;

- "updating said at least one server with respect to any operating system and application that is not validated for said process software, and providing any of said missing software applications for said at least one server required for said integration; identifying client addresses and checking client computers for operating systems, applications, and version numbers for validation with said process software, and identifying any software applications missing from said client computers that are required for integration" Col. 13-14 and Figs. 8-9;
- "updating said client computers with respect to any operating system and application that is not validated for said process software, and providing any missing software application for said client computers required for said integration; and installing said process software on said client computers and said at least one server" at Col. 13-14 and Figs. 8-9.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Shanahan's system to provide the integrating process software as taught by Conner be cause "it would be advantageous to provide a flexible IT model without the total cost of ownership problem associated with personal computing" as suggested by Conner at Col. 2 lines 54-56.

As per claim 2, Shanahan and Conner teach the method of claim 18 discussed above. Shanahan further teaches:

“prompting said user to select all or a portion of said reference materials; if selected, formatting said all or a portion of said reference materials; and entering said all or a portion of said reference materials into said active document” at [0139], [0340]-[0344], [0503], [0525].

As per claim 5, Shanahan and Conner teach the method of claim 18 discussed above. Shanahan also teaches:

“wherein said searching at least one database for said reference materials relating to said relevant keywords includes searching at least one of: a local database associated with said computer device” at [0450];

“and a remote database located in a network location external to said computer device” at [0297] and Fig. 3.

As per claim 6, Shanahan and Conner teaches the method of claim 1 discussed above. Shanahan also teaches: “wherein said displaying said reference materials on said computer device includes: intermittently flashing text of said reference materials on a computer screen of said computer device” at [0173].

As per claim 7, Shanahan and Conner teach the method of claim 18. Shanahan also teaches: “wherein said displaying said reference materials on said computer device

includes at least one of: displaying a Uniform Resource Locator associated with said reference materials on a computer screen of said computer device; and displaying a Uniform Resource Locator with a preview pane associated with said reference materials on a computer screen of said computer device” at [0179] and Fig. 10.

As per claim 8, Shanahan and Conner teach the method of claim 18. Shanahan also teaches: “wherein said displaying said reference materials on said computer device includes: displaying text of said reference materials on a computer screen of said computer device in response to a user highlighting a term or section of text within said active document” at [0318].

As per claim 9, Shanahan and Conner teaches the method of claim 18. Shanahan also teaches : “wherein said displaying said reference materials on said computer device includes performing at least one of: displaying images of said reference materials on a computer screen of said computer device in response to a user highlighting a term or section of text within said active document; displaying images in a preview pane of said reference materials on a computer screen of said computer device in response to a user highlighting a term or section of text within said active document” at [0579] and Figs. 64, 65.

As per claim 10, Shanahan and Conner the method of claim 18. Shanahan also teaches: “displaying text of said reference materials on a projector screen via a

presentation application executing on said computer device, said displaying text of said reference materials on a project screen performed in response to a user selecting said reference materials for display; wherein said projector screen is in communication with said computer device" at [0189], [0205].

As per claim 11, Shanahan teaches the method of claim 18 discussed above.

Conner also teaches:

- "deploying process software for providing said web-based electronic research and presentation functions via a document creation application, said deploying comprising: installing said process software on at least one server; identifying server addresses for users accessing said process software on said at least one server; installing a proxy server if needed" at Col. 6 lines 45-55;
- "sending said process software to said at least one server and copying said process software to a file system of said at least one server" at Col. 13 lines 43-55;
- "sending the process software to at least a first client computer; and executing said process software on said first client computer" at Col. 7 lines 25-40.

As per claim 12, Shanahan and Conner teach the method of claim 11 discussed above. Conner also teaches: "wherein said installing said process software further comprises: determining if programs will reside on said at least one server when said process software is executed; identifying said at least one server that will execute said

process software; and transferring said process software to storage for said at least one server” at Col. 16 lines 3-25.

As per claim 13, Shanahan and Conner teach the method of claim 11 discussed above. Conner also teaches: “wherein said sending said process software to said first client computer further includes having said at least one server automatically copy said process software to said first client computer, and running an installation program at said first client computer to install said process software on said first client computer” at Col. 11 lines 10-20.

As per claim 14, Shanahan and Conner teach the method of claim 11, Conner also teaches: “said sending said process software to said first client computer further comprises identifying a user and an address of said first client computer” at Col. 11 lines 10-20.

As per claim 15, Shanahan and Conner teach the method of claim 11, Conner also teaches: “said sending said process software to said first client computer includes sending said process software to at least one directory on said first client computer” at Col. 11 lines 10-20.

As per claim 16, Shanahan and Conner teach the method of claim 11, Conner also teaches: “said sending said process software to said first client computer includes

sending said process software to said first client computer via e-mail" at Col. 11 lines 10-20.

As per claim 17, Shanahan teaches the method of claim 18 discussed above. Shanahan does not explicitly teach the on demand sharing of process for performing functions as claimed. However, Conner teaches an on demand sharing of process software for providing said web-based application (Col. 7 lines 25-35) comprising:

- creating a transaction containing unique customer identification, requested service type, and service parameter" at Col. 13 lines 7-40;
- "sending said transaction to at least one main server" at Col. 13 lines 40-50;
- "querying said at least one main server about processing capacity associated with said at least one main server to help ensure availability of adequate resources for processing of said transaction" at Col. 14 lines 55-67, Col. 17 lines 4-18;
- "allocating additional processing capacity when additional capacity appears needed to process said transaction, said additional processing capacity being selected from the group of additional capacities consisting of central processing unit capacity, processor memory capacity, network bandwidth capacity and storage capacity" at Col. 14 lines 5-35, Col. 17 lines 4-18;

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Shanahan's system to provide a web based on demand sharing of process software as taught by Conner be cause "it would be advantageous to

provide a flexible IT model without the total cost of ownership problem associated with personal computing” as suggested by Conner at Col. 2 lines 54-56.

As per claim 19, Shanahan and Conner teach the method of claim 17, Conner also teaches: “recording a plurality of usage measurements selected from the group of usage measurements consisting of network bandwidth, processor memory, storage, and central processing unit cycles” at Col. 14 lines 49-51.

As per claim 20, Shanahan and Conner teach the method of claim 19, Conner also teaches: “summing said usage measurements; acquiring at least one multiplicative value associated with said usage measurements and with unit costs; and recording any such acquired multiplicative value as an on demand charge to a requesting customer” at Col. 14 lines 1-35.

As per claim 21, Shanahan and Conner teach the method of claim 20, Conner also teaches : “further comprising at least one of: posting said on demand charge on a web site if requested by said requesting customer; and sending said on demand charge via e-mail to said requesting customer's e-mail address” at Col. 14 lines 1-20.

As per claim 22, Shanahan and Conner teach the method of claim 20, further comprising “charging said on demand charge to said requesting customer's account if

an account exists and if said requesting customer has selected a charge account payment method" at Col. 14 lines 1-20.

Response to Arguments

5. Applicant's arguments with respect to claims 2, 5-22 have been considered but are not persuasive. The examiner respectfully traverses applicant's arguments.

Regarding claims 11, 18, applicant argued that Conner teaches "integrating process software for providing said web-based electronic research and presentation functions via a document creation application, said integrating comprising: determining if said process software will execute on at least one server; identifying an address of said at least one server; checking said at least one server for operating systems, applications, and version numbers for validation with said process software, and identifying any missing software applications for said at least one server that are required for integration; updating said at least one server with respect to any operating system and application that is not validated for said process software, and providing any of said missing software applications for said at least one server required for said integration; identifying client addresses and checking client computers for operating systems, applications, and version numbers for validation with said process software, and identifying any software applications missing from said client computers that are required for integration; updating said client computers with respect to any operating system and application that is not validated for said process software, and providing any missing software application for said client computers required for said

integration; and installing said process software on said client computers and said at least one server." On the contrary, Conner clearly teaches these limitation at Cols. 13-14 and Fig. 8-9. For example, Conner teaches at Col. 13 lines 5-6 that "All of the application hosting service are provided by service provider 610" which is mapped to the claimed "process software will executed on at least one server". Conner teaches at Col. 13 lines 30-35 that "The service manages both the registration of applications within the site including vendor information and profile information associated with each user/group and application pairing. Customer service 632 provides a set of customer-initiated account actions, which include viewing usage status, updating profile and payment information, managing the invited user access to an application instance, and closing an account. Customer service 632 also provides application support such as the support of the infrastructure and resources of the application", which is mapped to the claimed limitation "identifying an address of said at least one server; checking said at least one server for operating systems, applications, and version numbers for validation with said process software, and identifying any missing software applications for said at least one server that are required for integration"; Conner also teaches at Col. 13 lines 42-50 that "Application management 628 provides lifecycle management of hosted applications including installation, instantiation, updating, migration, suspension, and removal. The installation operation unpacks the application by following the instructions contained in the metadata of the package. It carries out specific tasks such as creating databases, installing EJBs, etc. Resource management 627 implements the negotiation, allocation, and removal of service provider site resources associated with an

application. The service provider advertises (supplies) a set of resources available on the site (such as JDBC, EJB, cig-bin) and the application requests a set of resources it needs to run" which is mapped to the claimed limitation "providing any of said missing software applications for said at least one server required for said integration; identifying client addresses and checking client computers for operating systems, applications, and version numbers for validation with said process software, and identifying any software applications missing from said client computers that are required for integration; updating said client computers with respect to any operating system and application that is not validated for said process software, and providing any missing software application for said client computers required for said integration; and installing said process software on said client computers and said at least one server".

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

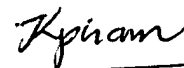
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Khanh B. Pham
Primary Examiner
Art Unit 2166



January 16, 2008